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EXAMINER

BIBBINS, LATANYA

ART UNIT

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2627

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/693,052 | Applicant(s) CHAN, YI-CHUNG | |
| | Examiner LaTanya Bibbins | Art Unit 2627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-31 and 39-48 is/are rejected.
- 7) ☒ Claim(s) 32-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In the remarks filed on September 15, 2008, Applicant amended claims 29-31, 35 and 36, submitted new claims 38-48, cancelled claims 7-10 and 21-28, and submitted arguments for allowability of pending claims 29-48.

Response to Arguments

2. Applicant's arguments, filed September 15, 2008, have been fully considered and are persuasive. The 35 U.S.C. 103(a) rejections of claims 29-38 have been withdrawn.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). There should be clear support or antecedent basis in the specification for the terminology used in the claims. Applicant employs the term "controller" in newly added claims 39-42, 44 and 45, the term "processor-readable medium" in newly added claims 46-48, and "computing"/"compute" in newly added claims 29-48. The terms do not appear in the specification. Correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2627

5. Claims 29-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement, i.e., are new matter. See MPEP § 2163 I(B).

Regarding claims 39-42, 44 and 45, in the amendment filed September 15, 2008, newly added claims 39-42, 44 and 45 recite “a controller.” However, the specification does not disclose a controller. Therefore, the controller of newly added claims 39-42, 44 and 45 is not supported by the as-filed disclosure, and the written description requirement is violated.

Dependent claim 43 does not resolve the 35 U.S.C. 112 first paragraph issues of claims 39 or 42 recited above and is therefore rejected as incorporating the deficiencies of a claim upon which it depends.

Regarding claims 46-48, in the amendment filed September 15, 2008, newly added claim 46-48 recite “a processor-readable medium storing instructions.” However, the specification does not disclose a processor-readable medium storing instructions. Therefore, the processor readable medium of newly added claim 46-48 is not supported by the as-filed disclosure, and the written description requirement is violated.

Regarding claims 29-38, 39-45, and 46-48, in the amendment filed September 15, 2008, the newly added claims 29-48 by virtue of independent claims 29, 39, and 46 recite “computing a distance” and “compute a distance”. However, the specification does not disclose such computing. Therefore, the computing of newly added claims 29-48 is not supported by the as-filed disclosure, and the written description requirement is violated.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. ***Claims 29-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.***

Claims 29-31 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must **(1) be tied to another statutory category (such as a particular apparatus)**, or **(2) transform underlying subject matter (such as an article or material) to a different state or thing**. While the instant claims recite a series of steps or acts to be performed, the claims neither transform underlying subject matter nor **positively tie to another statutory**

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Art Unit: 2627

category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

For example, the optical storage medium discrimination method of claims 29-31 recites the steps of computing a distance, determining a distance error, comparing the computed distance, and employing an alternate method. None of the recited steps explicitly or inherently positively recite an apparatus that accomplishes the recited method steps. The specification also fails to define the apparatus that accomplishes the steps of computing a distance, determining a distance error, comparing the computed distance, and employing an alternate method. Absent a special definition in the specification limiting the steps to a machine implementation, the claim is not properly tied to a statutory category that accomplishes the claimed method steps.

Applicant should note that in contrast, claims 32 and 37 respectively recite the steps of reading multiple data transition points and accessing synchronous data. Reading and accessing data from an optical storage medium inherently requires at least an optical pickup (i.e. an apparatus). Absent evidence or a special definition in the specification to contradict this general interpretation the claim inherently includes hardware for performance of the claimed steps, and is tied to a particular machine as a result.

Allowable Subject Matter

8. Claims 29-48 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 101 and the rejection under 35 U.S.C. 112, 1st paragraph, set forth in this Office action, respectively.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaTanya Bibbins whose telephone number is (571)270-1125. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LaTanya Bibbins/
Examiner, Art Unit 2627

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627